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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,565

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Kazushi Torii

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EXAMINER

BOYLE, ROBERT C

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,565	<b>Applicant(s)</b> TORII ET AL.	
	<b>Examiner</b> ROBERT C. BOYLE	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-2, 5-19, 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The new grounds of rejection set forth below are NOT necessitated by applicant's amendment filed on March 17, 2009, but results from additional relevant reference found after updating the prior art search. Thus, the following action is properly made NON-FINAL.

### ***Information Disclosure Statement***

3. Applicant has requested consideration of the corrected IDS filed on December 7, 2006. However, this document is not on record.

### ***Election/Restrictions***

4. Applicant's election without traverse of Group II, claims 3-4, 20-23, in the reply filed on March 17, 2009 is acknowledged.
5. Claims 1-2, 5-19, 24-31 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 17, 2009.

***Double Patenting***

6. Claims 3-4 and 22-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-11 of copending Application No. 11/540,478.

7. The rejection is adequately set forth in paragraphs 9-10 in the office action mailed on March 17, 2009 and is incorporated here by reference.

8. Claims 3-4 and 21-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/593,706.

9. The rejection is adequately set forth in paragraph 11 in the office action mailed on March 17, 2009 and is incorporated here by reference.

10. Claims 3-4 and 22-23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 and 17 of copending Application No. 10/577,355.

11. The rejection is adequately set forth in paragraph 12 in the office action mailed on March 17, 2009 and is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

12. Claims 3-4, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Adachi** (US 2005/0049379).

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13. As to claims 3-4, Adachi teaches a water absorbent of surface crosslinked resin particles of crosslinked polyacrylic acid where (a) the particles have a diameter of 850-150  $\mu\text{m}$  and the content of particles smaller than 850  $\mu\text{m}$  but not smaller than 150  $\mu\text{m}$  is not lower than 90 mass%, (b) the logarithmic standard deviation is in the range of 0.1-0.4, (c) the CRC in saline is not less than 5 g/g, (d) the absorption capacity with a load, corresponding to AAP, is not less than 20 g/g (abstract; ¶ 42, 47, 64-68, 86-101, 125-129). Adachi does not teach a “chemical cross-linking index against pressure” presented in formula 2 in claim 1. However, it is noted that the values of the CRC range plus values of the ‘absorption capacity with a load’ range taught by Adachi would overlap the claimed limitation of 100 or more: (5 g/g or more) + (20 g/g or more) = 25 g/g or more.

14. It is well settled that where prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See MPEP 2144.05; *In re Harris*, 409, F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 3d 1379, 1382 (Fed. Cir 1997); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

15. As to claim 20, Adachi teaches using phosphates as internal crosslinking agents (¶ 65, 71, 104).

16. Claims 21-22 state properties of the water absorbent: saline flow conductivity. While Adachi does not elaborate on the property, Adachi teaches essentially the same water absorbent and process as that of the claimed, and one of ordinary skill in the art would have a reasonable basis to believe the water absorbent of Adachi exhibits essentially the same properties. Since the

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PTO cannot conduct experiments, the burden of proof is shifted to the applicants to establish an unobvious difference. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

17. Even if properties of the water absorbent of the instant claims and the prior art examples are not the same, it would still have been obvious to one of ordinary skill in the art to make a water absorbent having the claimed properties because it appears that the references generically embrace the claimed water absorbent and one of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any, between the claimed water absorbent and the prior art give rise to unexpected results.

18. As to claim 23, Adachi teaches the addition of inorganic particles such as kaolin to the water absorbent (§ 199).

19. Claims 3-4 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakashima** (WO/02/100451).

20. The rejection is adequately set forth in paragraphs 20-25 in the office action mailed on March 17, 2009 and is incorporated here by reference.

### ***Response to Arguments***

#### **Claim Rejections under 35 U.S.C. 103 (Whitmore)**

21. Applicant's arguments with respect to Whitmore filed June 26, 2009 have been considered but are moot in view of the new ground(s) of rejection.

#### **Claim Rejections under 35 U.S.C. 103 (Nakashima)**

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22. Applicant's arguments filed June 26, 2009 with respect to Nakashima have been fully considered but they are not persuasive.

23. Applicant argues that Nakashima does not teach the limitations regarding the logarithmic standard deviation because Nakashima explicitly teaches the particles include at least two members of A1-A4, where A1 has particles 850-600  $\mu\text{m}$ , A2 is 600-500  $\mu\text{m}$ , etcetera.

24. This is not persuasive because Applicant has not shown that the ranges taught by Nakashima would necessarily fall outside the claimed range. It is the examiner's understanding that standard deviation is dependent on the distribution of the particle size. Therefore, a broad distribution leads to a broad standard deviation, and a narrow distribution leads to a narrow standard deviation. This will likewise affect the logarithmic standard deviation.

25. Applicant merely asserts that a combination of particle size ranges falls outside the claimed logarithmic standard deviation. Without additional evidence, Applicant's argument is not persuasive.

26. Applicant argues that Nakashima does not teach the limitations regarding the CRC range because Nakashima states the CRC is "not less than 31 g/g" (Nakashima: p 44) and the example of 13d is only a constituent of the water absorbing agent 13 (Nakashima: Table 2). This is not persuasive because particle 13d can act as a water absorbing agent in of itself, absent the other particles, as evidenced by the water absorption data collected and displayed in Table 2 and Nakashima stating "The results of measure the water-absorbing agents (13-a), (13-b), (13-c), and (13-d) as obtained were listed in Table 2." See p. 74, ln. 2-3. Therefore, the particles 13d fall within the scope of claim 3.

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27. Applicant argues that Nakashima teaches away from the claimed CRC range because Nakashima states the CRC is “not less than 31 g/g”, “more favorably not less than 32 g/g” etcetera (Nakashima: p 44). This is not persuasive.

28. “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Also, a preferred embodiment is not controlling, rather, all disclosures “including unpreferred embodiments” must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972).

29. Because Nakashima does not discredit the ranges below 31 g/g, and teaches an embodiment that falls within the claimed range (Nakashima: Example 13, Table 2), Nakashima does not teach away from the claimed invention.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. BOYLE whose telephone number is (571)270-7347. The examiner can normally be reached on Monday-Thursday, 9:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ROBERT C BOYLE/  
Examiner, Art Unit 1796

/Vasu Jagannathan/  
Supervisory Patent Examiner, Art Unit 1796